

REMARKS**INTRODUCTION:**

In accordance with the foregoing, the claims have been retained in their present form. No new matter is being presented, and approval and entry are respectfully requested.

Claims 20-21 are pending and under consideration. Reconsideration is respectfully requested.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

The patentability arguments below aid in understanding why the present claimed invention is patentable over the cited references.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at pages 2-4, claims 20-21 were rejected under 35 U.S.C. §103(a) as being obvious over USPN 6,091,808 (Wood et al.; hereafter, Wood) in view of USPN 6,870,828 (Giordano; hereafter, Giordano) or, in the alternative, under 35 U.S.C. §103(a) as obvious over Wood et al. in view of USPN 6,870,828 (Giordano III) (both of these sets of references appear to be the same). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

It should be noted that Wood, col. 6, line 56 through col. 7, line 9, recites:

On clicking the DIAL button 75, the web page manager 36 communicates a message, containing a dial request, a calling telephone number CN of the subscriber (as displayed in the frame 54), and a called telephone number DN from the windows 68, via the functions 38 and 44 to the call control interface 46, via which this message is forwarded via the path 44 and SCI 46 to the telephone switch 16. The switch 16 checks validity of the telephone numbers and that the subscriber's telephone 10 (calling telephone number CN) is on-hook, and provides a (possibly distinctive) ringing signal to the telephone 10. The subscriber, expecting this ring signal, takes his telephone 10 off-

hook, and this is detected by the telephone switch 16 in conventional manner, in response to which the switch 16 sets up the desired telephone connection to the called number DN in the same manner as if the number DN had been dialed by the subscriber at the telephone 10. Error and/or status messages can be communicated from the telephone switch 16 via the SCI 46, path 44, and functions 46, 44, and 38 to the web page manager 36, and displayed on the web page, as desired and appropriate. (emphasis added)

Hence, it is respectfully submitted that Wood recites that the telephone switch checks to see that the subscriber's phone is on-hook. The telephone switch then sends a ringing signal to the subscriber, the subscriber takes his phone off-hook, and the telephone switch sets up the desired telephone connection.

Giordano recites, col. 4, lines 20-46:

FIG. 3 is a flow chart of a method for accessing telephone numbers, according to the invention. To call a phone number, the user selects the icon by clicking on it, or by another suitable selection method (300). The Internet-capable phone makes the determination of how to initiate the call (305). If the user has a two-line phone, the Internet-capable telephone initiates a telephone call to the selected number (335). (emphasis added)

If the user has a one-line phone (315), the Internet-capable telephone first determines whether the line is available for a call. If the line is not currently being used for another telephone call or to connect to the Internet (325), the Internet-capable telephone initiates a voice call to the selected number (335). However, if the user is connected to the Web (320), the Internet-capable telephone automatically, and transparently, disconnects from the Internet session (330) and initiates a voice call to the selected telephone number. (emphasis added)

The Internet-capable telephone recognizes the conclusion of the call and terminates the telephone call session (340). The Internet-capable telephone may then automatically, and transparently, re-connect to the Web (345). If desired, this feature may be a user-determined preference. In alternative embodiments of the invention, the Internet-capable telephone may be configured to re-connect to the Web only when directed to do so by the user. The Internet-capable telephone is thus seamlessly integrated with the Web. (emphasis added)

Thus, Giordano recites determining how to initiate the call, using a second line if same is available, if a one-line phone is being used, initiating a voice call if the line is available, and disconnecting from the Internet and placing the voice call if the line is not available. Further, the user may be reconnected to the Internet after the call, which may be automatic or may be a choice of the user. These steps are complex, and necessitate greater complexity in the hardware or software of the telephone calling system of Giordano than in the telephone calling system of the present invention, which simply sets up the call and implements it.

Thus, if Wood is combined with Giordano:

the telephone switch determines how to initiate the call, i.e., checks to see if one line or two lines are being used by the user);

if the user has only one line and the one line is being used, the one line is disconnected and the voice call is placed (such that after the call, the user may choose to reconnect, or reconnection may be automatically achieved via hardware/software, depending on how the user has chosen or chooses at the time the call ends);

if the user has only one line, and the one line is not being used, the voice call is placed;
and

if the user has two lines and one line is available, the voice call is placed (such that after the call, the user may choose to connect to the Internet, or connection may be automatically achieved via hardware/software, depending on how the user has chosen or chooses at the time the call ends).

Clearly, the numerous operations obtained when combining Wood and Giordano are not equivalent to the less-complex operations utilized by the present claimed invention, which do not include analyzing the user's system to determine how to initiate the call.

Hence, even if combined, Wood and Giordano do not teach or suggest the present claimed invention. To adjust the combination of Wood and Giordano in an attempt to conform the combination to the present invention is the use of impermissible hindsight, as was set forth in In re Dembiczak, 50 USPQ2d at 1617 (Fed. Cir. 1999): "Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight." See e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed Cir 1985).

Thus, it is respectfully submitted that it is inappropriate to dismiss differences between the present claimed invention and the combination of cited references as "a design choice."

The Examiner submits (page 4 of the Office Action) that "Therefore, Wood et al. teach the claimed limitations except for explicitly teaching predetermined link syntax, automatically dialing based on the predetermined syntax and the communication channel being independent of the plug-in. However, it appears that Giordano III teaches such (see Abstract and at least Col. 3, lines 20-37). It would have been obvious to one of ordinary skill in the art to have incorporated such teachings as taught by Giordano, III into the Wood et al. device as nothing more than a design choice" (emphasis added). It is respectfully submitted that the courts have held that it is improper to base a rejection on the claimed feature being merely a design choice. See In re Garrett, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences ("Board") specifically stated: **"the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none. The examiner's assertion...that the proposed modification would have been "an obvious matter of**

engineering design choice well within the level of skill of one of ordinary skill in the art” is a conclusion, rather than a reason” (emphasis added). Similar discussions can be seen in *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1985).

Hence, it is respectfully submitted that claims 20 and 21 are non-obvious and patentable under 35 U.S.C. §103(a) over USPN 6,091,808 (Wood et al.) in view of USPN 6,870,828 (Giordano).

COMMENTS ON RESPONSE TO ARGUMENTS:

It is respectfully submitted that Giordano does not recite the combination of operations recited in the present claimed invention. The present claimed invention does not determine how to initiate the voice call. As noted above, combining Wood and Giordano simply recites a very complex hardware or software combination that is not as readily accomplished as the operations of the present claimed invention.

Further, as noted above, it is respectfully submitted that there is no teaching or suggestion of combining Wood and Giordano. As has been noted by the court:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention “as a whole.” **Inventions typically are new combinations of existing principles or features.** *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements.”). **The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.** (emphasis added)

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an “as a whole” assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. *See In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all

pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

June 30, 2006

By:

Darleen J. Stockley
Darleen J. Stockley
Registration No. 34,257

1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501